

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application Serial No. .... 10/004,089  
Filing Date .....October 23, 2001  
Inventor .....William A. Fischer  
Assignee ..... Hewlett-Packard Development Company, L.P.  
Group Art Unit ..... 2151  
Examiner .....K. Tang  
Attorney's Docket No.....PDNO. 10017888-1  
Confirmation No. .... 9254  
Title: .....COMPUTER-ASSISTED EQUIPMENT HAVING A USER INTERFACE...

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

Sir :

**REPLY BRIEF FOR APPELLANTS**

This is a reply in response to the Examiner's Answer dated September 17, 2008 of Application Serial Number 10/004,089. This Reply Brief is being submitted in accordance with 37 C.F.R. 1.193. The Commissioner is authorized to charge any fees required to deposit account no. 08-2025.

**I. REAL PARTY IN INTEREST**

The Examiner did not object to this section.

**II. RELATED APPEALS AND INTERFERENCES**

The Examiner did not object to this section.

**III. STATUS OF CLAIMS**

The Examiner did not object to this section.

**IV. STATUS OF AMENDMENTS**

The Examiner did not object to this section.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The Examiner did not object to this section.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Examiner did not object to this section.

**VII. CLAIMS APPENDIX**

The Examiner did not object to this section.

**VIII. EVIDENCE RELIED UPON BY THE EXAMINER AS STATED IN THE EXAMINER'S ANSWER**

US 2003/0074421 A1	Kusano et al.	04/17/2003
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US 6,144,375	Jain et al.	11/07/2000
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## **IX. REPLY TO THE GROUNDS OF REJECTION IN THE EXAMINER'S ANSWER**

The Examiner reiterated her rejection of claims 1-17, 24-26 and 33-36 under 35 U.S.C. §103(a) as being unpatentable over Kusano et al. in view of Jain et al.0036

The Appellants respectfully traverse this rejection and submit that the combined references do **not** disclose, teach or suggest all of the features of the claims.

For example, Jain et al. merely disclose a buffer with computer assisted equipment receiving video information and Kusano et al. simply disclose providing a user with a user interface for consumer electronic devices. Although Jain et al. disclose allowing a user to freeze a video frame and replaying archived data, the combined references still **fail** to disclose, teach, or suggest the Applicants' claimed **programming the selectors** to use buffered content to perform freeze frame and instant replay functions and displaying pertinent text information on the display **while** the remote control device receives interface instructions and controls the content.

Hence, when Jain et al. is combined with Kusano et al., this combination merely discloses using a viewer with a user interface having a first window for displaying a two-dimensional representation of a three-dimensional model of the real world environment (see paragraph 0031 of Kusano et al. and the Abstract and Summary of Jain et al.). However, the combination does not program the selectors to use buffered content to perform freeze frame and instant replay functions and display pertinent text information on the display while the remote control device receives interface instructions and controls the content, like the Applicants' independent claims.

Last, with regard to the rest of the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03).

Therefore, since the combined cited references do not disclose, teach or suggest all of the features of the independent claims, the combined cited references cannot render the claims obvious. As such, the appellants respectfully request that the rejections of the claims under 35 U.S.C. § 103 based on Kusano and Jain et al. be withdrawn.

#### **X. REPLY TO THE EXAMINER'S ARGUMENT IN THE EXAMINER'S ANSWER**

In the first (1) response to the Appellants' arguments, the Examiner argued that *"...the programming of the interface to include these selector buttons would inherently include the programming of the functionalities of these buttons. It would not be reasonable to include these buttons on the graphical user interface but without programmably enabling the functions of them."*

Clearly, the Examiner could not find all of the features of the Appellants' independent claims in the cited references, so the Examiner attempted to use impermissible hindsight to form this conclusion when she mischaracterized both Kusano et al, and the appellants' claims. It is well-settled law that the Examiner must have a reasonable basis for her conclusions. Namely, the Examiner cannot broadly mischaracterize the references and/or the appellants' claims and then use hindsight to arbitrarily find an "inherent" element in the references to support her rejection, which is the case here. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

Also, in the second (2) response, the Examiner merely cited to *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) and concluded that *"any judgment on obviousness is in a sense necessarily based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure..."*

However, the Examiner did in fact *include knowledge gleaned only from the applicant's disclosure* when she rejected the claims. This is because the combined cited references clearly do **not program the selectors** to use buffered content to perform **freeze frame and instant replay** functions and display pertinent text information on the display **while** the remote control device **receives interface instructions and controls the content**, like the Appellants' claimed invention. Although the Examiner argued that the *"...selectors must have been programmed when the display is made, in order to provide these capabilities in the display."*, this argument is based on hindsight because Kusano et al. do **not** provide these functions and features in the first place, so Kusano et al. **cannot** inherently disclose, teach or suggest the Appellants' capabilities.

Hence, the Examiner improperly mischaracterized the cited references as well as the Appellants' claims. **When the reference in question seems relatively similar to the Examiner**, "...the opportunity to judge by hindsight is particularly tempting." *McGinley v. Franklin Sports Inc.*, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [*emphasis added*]. Since the Examiner's rejection is unquestionably based on hindsight, the rejection is improper and must be withdrawn. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*

**XI. RELATED PROCEEDINGS APPENDIX**

The Examiner did not object to this section.

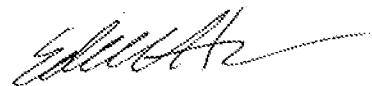
**XII. CONCLUSION**

For the foregoing reasons, it is submitted that the Examiner's rejection of the claims was erroneous, and reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,

Date: November 13, 2008

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